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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,635	02/15/2002	Masayuki Inai	KOT-0039	5481
7590	10/03/2006		EXAMINER	
CANTOR COLBURN LLP 55 Griffin Road South Bloomfield, CT 06002			SHERR, CRISTINA O	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/077,635	Applicant(s) INAI ET AL.	
	Examiner Cristina Owen Sherr	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 6-20, 27-29 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 6-20, 27-29 and 34-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to applicant's amendment filed May 15, 2006.

Claims 9-11, 34-35, and 38-40 have been amended. Claims 2-4, 6-20, 27-29 and 34-40 are currently pending in this case.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 13, 2006 has been entered.

Response to Arguments

3. Applicant's arguments, see applicant's amendment, filed May 15, 2006, with respect to the section 112 rejections of claims 2-4, 6-20, 27-29 and 34-40, as currently amended, have been fully considered and are persuasive. The section 112 rejection of claims 2-4, 6-20, 27-29 and 34-40 has been withdrawn.

4. Applicant's arguments with respect to the section 103 rejections of claims 2-4, 6-20, 27-29 and 34-40 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3621

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4, 6-20, 27-29 and 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onodera et al (US 6700677) or Holmes et al (US 6119108) in view of Auerbach et al (US 5673316) and Shima (US 6369909).

7. Regarding claim 34 –

Onodera (See, e.g., abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes (See, e.g., abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) discloses printing system including a server that protects copyright and includes encryption control substantially as claimed. Auerbach (See, e.g., Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) shows encryption of document parts. Shima (See, e.g., Figs. 14, 19, Col. 6, lines 50-65, and Col. 21, lines 5-20) shows security level queries and control of network printers as being old and obvious (Note Epson assignee).

8. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera or Holmes because the encryption control of Auerbach provides a much finer level of control of an electronic document because it caters to a multiplicity of users that may not need the entire document and therefore expands the market and provides greater levels of revenue, to the copyright holder.

9. Regarding the protection limitations of claim 2 –

Onodera (See, e.g., abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes (See, e.g., abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46),

(See, e.g., Figs. 14, 19, Col. 6, lines 50-65, and Col. 21, lines 5-20) shows security level queries and

Art Unit: 3621

disclose a printing system including a server that protects copyright and includes encryption control that is a functional equivalent of the claim limitations.

10. Regarding the encryption limitations of claim 3 –

Auerbach (See, e.g., Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) shows encryption of document parts that is a functional equivalent of the claim limitations.

11. Regarding the output limitations of claim 4 –

Onodera (See, e.g., abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes et al (See, e.g., abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose a printing system including a server that protects copyright and includes encryption control that is a functional equivalent of the claim limitations.

12. Regarding the printing limitations of claims 6-8 –

Onodera (See, e.g., abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes (See, e.g., abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose a printing system including a server which protects copyright and includes encryption control which is a functional equivalent of the claim limitations because the elements are conventional component of a standard printing system.

13. Regarding the protection limitations of claims 9-20 –

Auerbach (See, e.g., Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) shows encryption of document parts that is a functional equivalent of these claim limitations.

14. Regarding the protection limitations of claims 27-29 –

Auerbach (See, e.g., Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) shows encryption of document parts that is a functional equivalent of the claim limitations.

Art Unit: 3621

15. Regarding the system limitations of claims 35-37 –

Auerbach (See, e.g., Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) shows encryption of document parts that is a functional equivalent of the claim limitations.

16. Regarding claim 38 –

Onodera (See, e.g., abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes (See, e.g., abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) discloses printing systems including a server that protects copyright and includes encryption control substantially as claimed. Auerbach (See, e.g., Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) shows encryption of document parts. Shima (See Figs. 14, 19, Col. 6, lines 50-65, and Col. 21, lines 5-20) shows security level queries and control of network printers as being old and obvious (Note Epson assignee).

17. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera or Holmes because the encryption control of Auerbach provides a much finer level of control of an electronic document because it caters to a multiplicity of users that may not need the entire document and therefore expands the market and provides greater levels of revenue to the copyright holder.

18. Regarding claim 39 –

Onodera (See, e.g., abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes (See, e.g., abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) discloses printing system including a server that protects copyright and includes encryption control substantially as claimed. It is noted that it is believed that the copyright controls of the document are functionally equivalent to the claimed limitations.

It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera or Holmes because the encryption control of

Art Unit: 3621

Auerbach (See, e.g., Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) shows encryption of document parts. Shima (See, e.g., Figs. 14, 19, Col. 6, lines 50-65, and Col. 21, lines 5-20) shows security level queries and control of network printers as being old and obvious (Note Epson assignee).

19. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera or Holmes because the encryption control of Auerbach provides a much finer level of control of an electronic document because it caters to a multiplicity of users that may-not need the entire document and therefore expands the market and provides greater levels of revenue to the copyright holder.

20. Regarding claim 40 –

Onodera (See, e.g., abstract, Figs. 1, 4 and 5, Col. 1, lines 40-65, claims 1-8) or Holmes (See, e.g., abstract, Figs. 1 and 2, Col. 2, lines 5-65, Col. 3, lines 10-50, claims 1-46) disclose printing systems including a server which protects copyright and including encryption control substantially as claimed. It is noted that it is believed that the copyright controls of the document are functionally equivalent to the claimed limitations.

Auerbach (See, e.g., Fig. 2, Col. 1, lines 50-65, Col. 5-40, claims 1-8) shows encryption of document parts. Shima (See, e.g., Figs. 14, 19, Col. 6, lines 50-65, and Col. 21, lines 5-20) shows security level queries and control of network printers as being old and obvious (Note Epson assignee).

21. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Onodera or Holmes because the encryption control of Auerbach provides a much finer level of control of an electronic document. because it

Art Unit: 3621

caters to a multiplicity of users that may not need the entire document and therefore expands the market and provides greater levels of revenue to the copyright holder.

22. Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3621

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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